

### REMARKS

Claims 1-11 are pending in this application. By this amendment, claims 1-9 are cancelled without prejudice or disclaimer, claims 10 and 11 are amended and new claims 12-19 are added. Following entry of this amendment, claims 10-19 will be pending. Applicants note that the title and abstract are also amended. Support for the amendments and new claims is found throughout the specification and originally filed claims, including, e.g., page 6, lines 14-16; originally filed claims 3, 4, 5, 6, 8. No new matter is added by this amendment. Entry of this amendment is respectfully requested.

With respect to all amendments and cancelled claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any objection and/or rejection made by the Office. Applicants expressly reserve the right to pursue prosecution of any subject matter not presently claimed in one or more future or pending continuation and/or divisional applications.

Applicants thank the Examiner for considering and initialing the PTO Forms 1449 that were mailed with the Office Action. Applicants note that a Supplemental Information Disclosure Statements were mailed February 24, 2006 and June 29, 2006. Consideration of the references submitted therein and return of initialed PTO Form 1449s is respectfully requested.

#### ***Rejection Under 35 U.S.C. § 101***

Claims 1-11 are rejected under 35 U.S.C. § 101 because the claims are allegedly drawn to non-statutory subject matter. Claims 1-9 have been cancelled. Applicants will address this rejection as it applies to claims 10 and 11, and as it might be applied to new claims 12-19. By this amendment, claims 10-11 are amended and now state “mouse” (rather than “mammal”). New claim 19 also uses the term “mouse”. Applicants respectfully submit that these amendments obviate the rejection. Prompt withdrawal of this rejection is respectfully requested.

#### ***Rejection Under 35 U.S.C. § 112, First Paragraph (written description)***

Claims 1-11 are rejected under 35 U.S.C. § 112 first paragraph as allegedly failing to comply with the written description requirement. Applicants respectfully disagree that the specification fails to describe the invention as claimed. However, by this amendment, claims 1-9 are cancelled and claims 10 and 11 have been amended and now recite “mouse” (rather than “mammal”). New claim 19 also recites the term “mouse”. Applicants submit that the present claims are fully described by the specification. Indeed, the Office Action acknowledged that “the specification provides guidance and/or evidences regarding generation of a transgenic mouse with FGF19 driven by MLC promoter and its characterization . . . and a method of drug screening”

(Office Action, page 3)(emphasis in original). Accordingly, withdrawal of this rejection is respectfully requested.

***Rejection Under 35 U.S.C. § 112, First Paragraph (enablement)***

Claims 1-11 are rejected under 35 U.S.C. § 112 first paragraph as allegedly lacking enablement on the ground that the specification

while being enabling for (1) a transgenic mouse whose genome comprises: an integrated nucleic acid construct comprising a promoter operably linked to nucleic [sic] acid coding for FGF 19 polypeptide and wherein said mouse acquired hepatocellular carcinoma, proliferation of pericentral hepatocytes and exhibits elevated level of alpha-fetoprotein and (2) for a isolated cell from said transgenic mouse and a method of screening for biologically active agents that can affect FGF-19 associated hepatocellular carcinoma using said mouse or said cell, it does not reasonably provide enablement for the full scope, which embraces all transgenic mammals” (Office Action, page 5).

Applicants respectfully disagree that claims 1-11 lack enablement. However, by this amendment, claims 1-9 are cancelled and claims 10 and 11 have been amended and now recite “mouse” (rather than “mammal”). New claims 12-19 also recite the term “mouse”. Applicants submit that the presently pending claims are fully enabled by the present application. Indeed, the Office Action acknowledged that the present application enables methods of screening for biologically active agents that can affect FGF-19 associated hepatocellular carcinoma using a transgenic mouse or an isolated cell from a transgenic mouse (Office Action, page 5)(quoted above). Accordingly, withdrawal of this rejection is respectfully requested.

***Rejection Under 35 U.S.C. § 102***

Claims 1-9 are rejected under 35 U.S.C. § 102 as allegedly anticipated by Stewart et al. (Pub No. US 2002/00442367 A1, April 11, 2002: of US Patent Appln. No. 09/767,609, filed January 22, 2001)(“Stewart”). Claims 1-9 have been cancelled. Applicants will address this rejection as it applies to claims 10 and 11, and as it might be applied to new claims 12-19. Applicants respectfully traverse this rejection.

Stewart does not disclose methods for screening for biologically active agents that modulate a phenomenon associated with hepatocellular carcinoma, as required by the presently pending claims. Accordingly, Stewart cannot anticipate the present claims. Prompt withdrawal of this rejection is respectfully requested.

***Rejection Under 35 U.S.C. § 102(a)***

Claims 1-11 are rejected under 35 U.S.C. § 102(a) as allegedly anticipated by Nicholes et al., American Journal of Pathology 2002, 160: 2295-2307 (“Nicholes”). Applicants respectfully

traverse this rejection. Claims 1-9 have been cancelled. Applicants will address this rejection as it applies to claims 10 and 11, and as it might be applied to new claims 12-19.

Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. § 102(a).<sup>1</sup> MPEP § 2132.01; *In re Katz*, 687 F2d 450, 215 USPQ 14 (CCPA 1982). Where an application is one of the co-authors of a publication cited against his or her application, the publication may be removed as a reference by the filing of an affidavit made out by the author establishing that the article is describing applicant's own work. *Id.*; see also *Ex parte Kroger*, 219 USPQ 370 (BPAI 1982).

Submitted herewith as Appendix A is the unsigned Declaration of Dorothy French under 37 CFR § 1.132, in which Dr. French states that she is an author of the Nicholes paper and that she and co-author Jean-Philippe Stephen are the only authors of the Nicholes paper who inventively contributed to the subject matter of the Nicholes paper. Applicants will submit a signed version of this Declaration as soon as possible. Applicants respectfully submit that this Declaration establishes that the Nicholes paper describes the work of the present inventors. Accordingly, the Nicholes reference is removed as a reference, and is not properly citable in this rejection. Withdrawal of this rejection is respectfully requested.

***Rejection Under 35 U.S.C. § 103(a)***

Claims 1-11 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Nicholes et al, (American Journal of Pathology 2002, 160:2295-2307) in view of Botstein et al (USPTO Pub. No. US 2002/00112961). Applicants respectfully traverse this rejection.

As noted above, Nicholes describes applicants' own work and is thus properly removable as a reference under 35 U.S.C. § 102(a). Thus, Nicholes may not be considered in this rejection. The Botstein application neither teaches nor suggests methods for screening for biologically active agents that modulate a phenomenon associated with hepatocellular carcinoma as required by the present claims. Prompt withdrawal of this rejection is respectfully requested.

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<sup>1</sup> For the record, Applicants do not concede that Nicholes is a reference under 102(a). The date of publication of the Nicholes paper is "June 2002" on the Nicholes paper; thus, the precise date of publication of this article has not been established.

### SUMMARY

Applicants believe that this application is now in condition for allowance and respectfully requests that the outstanding rejections be withdrawn and this case passed to issue. The Examiner is invited to contact the undersigned at (650) 467-6222 in order to expedite the resolution of any remaining issues.

In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Respectfully submitted,  
GENENTECH, INC.

Date: July 5, 2006

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